

## REMARKS

This application has been carefully reviewed in light of the Office Action dated May 14, 2007. The following claims are pending in the application: Claims 154 to 156, 158 to 161, 163, 164, 166 to 171, 173 to 176, 207 to 210 and 212 to 219. Of those claims, Claims 154 and 210 are still the only independent claims. Reconsideration and further examination are respectfully requested.

Two formal matters will be addressed before turning to the substantive merits of the Office Action. The first involves the substitute specification that was submitted with the Amendment dated July 5, 2001 (filed on July 10, 2001). Applicants had previously requested an acknowledgment that this substitute specification has been entered, but the instant Office Action stated that the substitute specification “could not be found” (see page 2). Further close inspection of the filewrapper for this application reveals that the substitute specification has indeed been entered, although it curiously was entered with a filing date of February 6, 1997. A copy of the first page of the substitute specification is attached hereto, bearing the Examiner’s hand-marked instructions to “please enter”. Accordingly, it is believed that this matter is resolved, although Applicants do not understand the Examiner’s reference to a substitute specification dated February 6, 2007.

The second matter involves the Information Disclosure Statement dated May 16, 2006 (filed May 17, 2006). The instant Office Action indicated that this Information Disclosure Statement did not include a form PTO-1449. Accordingly, an

appropriate form PTO-1449 is attached. Consideration of the cited document is respectfully requested.

It is noted that a further Information Disclosure Statement, dated September 11, 2007, has been filed. Consideration of the cited art is respectfully requested.

Turning to the merits of the Office Action, formal objections were lodged against Claims 161, 166, 167 and 212, with a request being made to change “said other side” to “said second side”. The requested changes have been made.

All claims were rejected under 35 U.S.C. § 103(a), primarily over U.S. Patent 5,552,816 (Oda) in view of Japan 4-32577 (Takise) for which a translation was provided. This rejection was maintained from prior Office Actions, and additionally was marked as “final”. The rejection is respectfully traversed.

In maintaining the rejection, the Office Action explains (at pages 9 and 10 thereof) that the upward or downward direction of Takise’s supporting member 55 is a relative direction, which depends on the direction of observation. Accordingly, the Office Action gave virtually no weight to the direction of the claimed extension, stating that it would be possible to view Takise’s arrangement in an upside-down orientation. Applicants respectfully disagree with the treatment afforded to the claim language, and further disagree with the interpretation given to Takise.

First, with respect to the treatment given to Takise, and the assertion that it would be possible to view the Takise arrangement in an upside-down orientation, Applicants respectfully assert that this treatment is contrary to established patent precedent. Reference is made to *In re Gordon*, 221 USPQ 1125 (CAFC, 1984), which is discussed at

MPEP § 2143.01. In *Gordon*, the claims were directed to a blood filter assembly in which inlets and outlets were located at the bottom and a gas vent was located at the top. The prior art taught a liquid strainer for gasoline, in which the inlet and outlet were located at the top and a stopcock was located at the bottom. The Board reasoned that the claimed device would have been obvious since it would have been obvious to turn the reference's device upside-down. The Board's decision was reversed on appeal. In reversing the Board's decision, the Federal Circuit specifically noted that the mere fact that a prior art could be modified by turning it upside-down does not make such a modification obvious unless the prior art suggested the desirability of this modification.

Applying the facts and analysis of *Gordon* to this case, it is respectfully submitted that the rejection over Takise must be withdrawn. As specifically noted by the Federal Circuit in *Gordon*, "the question is not whether a patentable distinction is created by viewing a prior art apparatus from one direction and a claimed apparatus from another, but, rather, whether it would have been obvious from a fair reading of the prior art reference as a whole to turn the prior art apparatus upside-down". (*Id.* at page 1127). Here, as in *Gordon*, there is no reason to turn the figures of Takise upside-down, as asserted at page 9 and 10 of the Office Action. Moreover, as in *Gordon*, even if there were a reason to turn the figures of Takise upside-down, the wrong question is still being answered.

Furthermore, in an effort to distinguish the arrangement of Takise from that of the claimed invention, the claims have been amended so as to specify that the claimed "downward direction" is relative to an orientation in use. Specifically, the claims specify

that the supply port is disposed at a “bottom side” which faces to the ink supply tube “when said liquid container is mounted in the holder”. The claims further specify that the elastic supporting member extends downwardly from “an upper portion” which is opposite to the bottom side, and that the elastic supporting member extends downwardly from the upper portion toward the bottom side. Accordingly, there can be no mistake over the direction in which the elastic supporting member extends, and this direction is entirely different from anything that might be shown in Takise.

Accordingly, it is respectfully submitted that the rejection over Takise should be withdrawn.

Applicants further challenge the Office Action’s statement that it would have been obvious to combine Oda and Takise. Page 6 of the Office Action articulates a rationale as to why such would have been obvious:

“Therefore, it would have been obvious for one having ordinary skill in the art at the time the invention was made to replace one of two engagement portions disclosed by Oda et al. by the elastic nail and the other by the engaging portion for pivotally holding the ink container during mounting as disclosed by Takise. The motivation for doing so is to enable manipulation with a single hand to load and unload the ink cartridge to or from the holder with safety and ease as taught by Takise (*See page 8, third paragraph of the translation*).” (Office Action, page 6, emphasis in original.)

However, although both the invention and Oda are directed to an ink container for an ink jet printing, Takise is not. Takise is directed to a cassette for holding the inked ribbon for a dot-matrix printer. As such, Takise is completely non-analogous to the subject application, and cannot be relied on in a rejection of the claims:

“In order to rely on a reference as a basis for rejection of an Applicant’s invention, the reference must either be in the field of Applicant’s endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned.” (MPEP § 2141.01(a), quoting *In re Oetiker*.)

Pursuant to the two-part framework quoted above, it is clear that Takise is not in the field of Applicant’s endeavor. The question, therefore, is whether Takise is “reasonably pertinent to the particular problem with which the inventor was concerned.”

A reference is “reasonably pertinent” if it is one which, because of the matter with which it deals, logically would have commended itself to an inventor’s attention in considering his problem. MPEP § 2141.01(a), quoting *Wang Laboratories*. Here, according to the Applicants’ specification, the problem that they were addressing was the desire to reduce complicated mounting structures of prior art apparatuses, while at the same time also making more effective utilization of the internal space for storing ink. See, for example, paragraph [0016] of the substitute specification.

Takise, therefore is irrelevant to the inventors’ endeavors, inasmuch as it is related to a holder for an ink ribbon and could not possibly shed any light of the ability to more effectively utilize available internal space for storing ink. Takise, therefore, does not logically commend itself to the Applicants’ endeavors, and is consequently non-analogous art over which a rejection cannot be sustained.

Moreover, even when considered in the impermissible combination asserted by the Office Action, Takise is still not seen to disclose or to suggest at least the claimed elastic supporting member. According to the Office Action, Takise’s claw 55 is said to correspond to the claimed elastic supporting member. In Takise, the operating portion of

claw 55 is found at the free end thereof. The engaging portion of Takise's claw 55 is found between the base portion and the free end.

In contrast, according to the claimed invention, the second engaging portion is disposed at a position closer to a free end of the elastic supporting member than the operating portion. This claimed arrangement is different from anything shown in Takise.

It is therefore respectfully submitted that the function, structure and effect of Takise's pawl 55 are all entirely different than the claimed elastic supporting member.

Withdrawal of the rejection under § 103(a) is therefore respectfully requested.

REQUEST FOR INTERVIEW

An interview is respectfully requested. To facilitate the scheduling of the interview, and the collection and preparation of exhibits that might be shown at the interview, a Request is being filed concurrently herewith, for suspension of action for a three month period.

The undersigned will telephone the Examiner within the next few weeks, so as to schedule an interview. If the Examiner reaches this case for action before then, he is respectfully requested to contact the undersigned at (714) 540-8700.

Applicants' undersigned attorney may be reached in our Costa Mesa, California office at (714) 540-8700. All correspondence should continue to be directed to our below-listed address.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read "Michael K. O'Neill", is written over a horizontal line.

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